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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,081	07/18/2003	John T. Stites	31970.12	3303

27683 7590 03/09/2004  
HAYNES AND BOONE, LLP  
901 MAIN STREET, SUITE 3100  
DALLAS, TX 75202

EXAMINER

PASSANITI, SEBASTIANO

ART UNIT PAPER NUMBER

3711

DATE MAILED: 03/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/623,081	STITES ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Sebastiano Passaniti	3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1 and 33-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 33-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>07/18/2003</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

This Office action is responsive to communication received 07/18/2003 – applications papers filed.

This application is a CON of 10/195,184, filed 07/16/2002, now US Pat. No: 6,595,870, which is a CON of 09/904,184, filed 07/12/2001, now US Pat. No: 6,450,897, which is a CON of 09/476,573, filed 01/03/2000, now U.S. Pat. No: 6,280,348, which is a CIP of 08/989,817, filed 12/12/1997, now U.S. Pat. No: 6,077,173.

Claims 1 and 33-51 are pending.

Following is an action on the MERITS:

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 and 47-51 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of each of U.S. Patent Nos: 6,595,870; 6,450,897; 6,280,348 and 6,077,173 in view of Aizawa ('194). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed device of each of the patented files is more specific than the requirements set forth for the instant claimed invention. The patented devices all require a back defined by a second plane with a cavity formed in the back surface and having a first larger portion adjacent the toe and a second smaller portion adjacent the heel. Therefore, the patented devices include all of the limitations set forth for the instant claimed invention. Moreover, removing this limitation ("*...defined by a second plane which is inclined relative to the first plane defining the face, the back being...single open...and covering a majority of the back, the cavity having a first larger portion adjacent the toe and a second smaller portion adjacent the heel*") from the prior art devices in order to redistribute the weight of the head would have been obvious to one of ordinary skill in the art in view of the patent to Aizawa, which shows it to be old to change the cavity arrangement, i.e., the size of the cavity in the rear of the head adjacent the heel and toe portions, in a set of clubs based up the weight requirements for each style of club. See Figures 16, 18 and 20 and the accompanying description for these figures, as well as the prior art disclosed in Figures 25, 26 and 27 in Aizawa.

Note, the instant claims 1 and 47-51 share a direct correlation in terms of claim limitations with their respective counterparts in the prior patents cited. For example, instant claims 1 and 47-51 correspond to claims 1-6 in the '870 patent. A similar observation may be made between the instant claims and the claims of the remaining prior patents. A further explanation of each of the remaining claim correspondence will not be presented here, for brevity.

Claims 33-51 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 7-20 of U.S. Patent No. 6,595,870 in view of Antonious ('993). Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims merely introduce the language "the heel perimeter and the toe perimeter portion" (claim 33) along with "the toe perimeter portion and the heel perimeter portion" (claim 40). The addition of these phrases is deemed to merely introduce another obvious variant of the connection arrangement for the already recited bridge member. Further rearrangement of the bridge member to provide yet another convenient weight distribution would have been obvious in view of the patent to Antonious, which shows, by way of a plethora of examples, that it is old to reposition a bridge member located to the rear of a cavity-backed iron club head in order to selectively provide added weight to areas of the club that are more susceptible to being struck by an off-center shot.

Enclosed with this Office action is a sample terminal disclaimer which is effective to overcome an obviousness-type double patenting rejection over a prior patent (37 CFR 1.1321(b) and (c)).

Also enclosed is a sample Statement Under 37 CFR 3.73(b) (Form PTO/SB/96) which an assignee may use in order to ensure compliance with the rule. Part A of the Statement is used when there is a single assignment from the inventor(s). Part B of the Statement is used when there is a chain of title. The "Copies of assignments..." box should be checked when the assignment document(s) (set forth in part A or part B) is/are not recorded in the Office, and a copy of the assignment document(s) is/are attached. When the "Copies of assignments..." box is checked, either the part A box or the part B box, as appropriate, must be checked, and the "Reel\_\_\_\_, Frame\_\_\_\_" entries should be left blank. If the part B box is checked, and copies of assignments are not included, the "From:\_\_\_\_ To:\_\_\_\_" blank(s) must be filled in. This statement should be used the first time an assignee seeks to take action in an application under 37 CFR 3.73(b), e.g., when signing a terminal disclaimer or a power of attorney.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 47-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Antonious ('993) or Aizawa in view of Antonious ('172). With respect to Antonious ('993), every feature claimed is shown except for a bridge member that superposes a portion of the rear cavity in the head wherein the bridge member is spaced from the rear surface and comprises a first and second metal. Antonious ('172) shows it to be old in the art to provide a bridge member that is spaced from the rear wall of the striking face to provide a softer feel upon impact with a golf ball. See column 8, lines 1-18. Antonious ('172). In view of the patent to Antonious ('172), it would have been obvious to modify the device in the cited art reference to Antonious ('993) by spacing the bridge member (30) shown in Figure 2, the motivation being to provide a softer impact between

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the striking face and a golf ball. Further, it is noted that Antonious ('172) teaches that the weight or bridge members (32,34) may be formed of a combination of materials, therefore satisfying applicant's requirement that the bridge members be formed of first and second materials. See column 5, lines 5-35 in Antonious ('172). Any further configuration, such as required by claims 47-51, over those shown or suggested by Antonious ('993) are deemed to be obvious variations thereof. Accordingly, it would have been obvious to modify the device in the cited art reference to Antonious ('993) by providing for a bridge member (30) as shown in Figure 2 made of at least two materials, the motivation being to provide a desirable way of distributing the weight of the head.

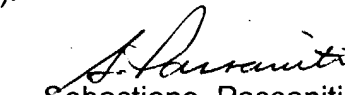
With respect to the Aizawa reference in view of Antonious ('172), applicant's attention is drawn to Figures 9 and 10 in Aizawa showing a bridge member (75). For purposes of brevity, the explanation of modifying the Aizawa device in view of the teachings of Antonious ('172) will not be highlighted here, since the same line of reasoning applies here as was the case for the modification of Antonious ('993) in view of Antonious ('172) described supra.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 703-308-1006. The examiner can normally be reached on Mon-Fri (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Sebastiano Passaniti  
Primary Examiner  
Art Unit 3711

S.Passaniti/sp  
March 8, 2004